REMARKS

The Office Action dated September 14, 2009 ("Office Action") has been thoroughly reviewed and Applicants submit that all issues raised therein have been addressed in this response. Claims 1–35 are pending in the subject Application, with claims 1, 18, 19, 25, 28 and 32 being independent. Claims 36–39 are new. No new matter has been added.

I.   35 U.S.C. § 103—Gusler In View of Herland

Claims 1, 3–4, 6–11 and 18–35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. Appl. Publ. No. 2002/0178072 to Gusler *et al.* ("Gusler") and further in view of U.S. Pat. Appl. Publ. No. 2003/0018747 to Herland *et al.* ("Herland"). Applicants respectfully traverse this rejection.

A. Gusler

The Examiner contends that Gusler discloses every element in independent claims 1, 18, 19, 25, 28 and 32 except "wherein the web page that the user is accessing and each of the web pages accessed by the other users comprise any web page on the Internet." (Office Action, pp. 2–3) Applicants respectfully disagree—Gusler plainly fails to disclose at least the following additional element of Applicants' recited independent claims:

> "calculating a virtual distance **between a web page that a user is accessing** through a first terminal **and web pages accessed by other users** through one or more second terminals"

Gusler is directed to an online shopping mall software program. The program allows users to join an online shopping experience to shop with other friends within an online shopping mall. Gusler provides users with a visual depiction of a mall directory, as shown below in Figure 4:
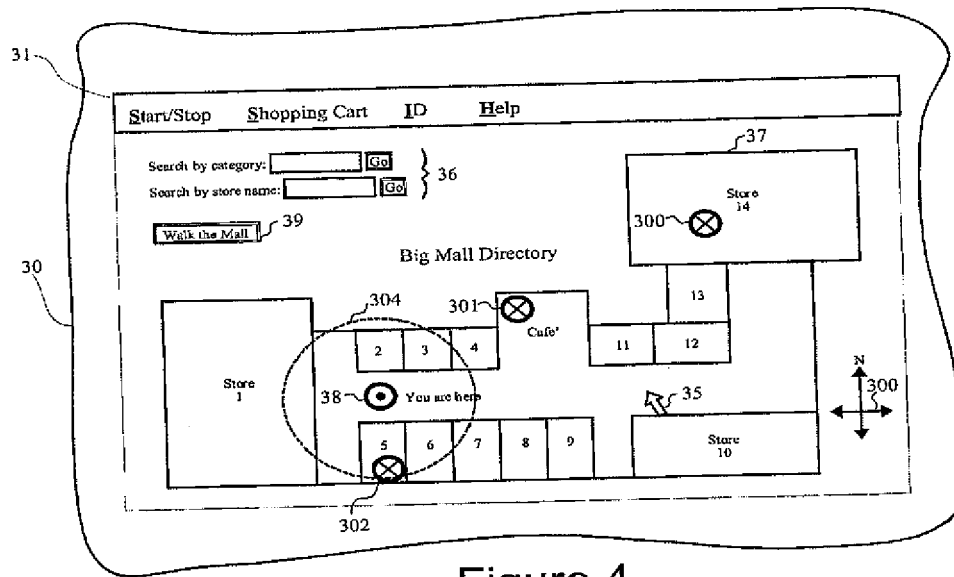
Figure 4

One feature of the software is assisting shoppers with locating other shoppers within the mall. For example, the Gusler system may assist shopper 38 (in Figure 4) in locating one or more other shoppers (300, 301, 302) by identifying and comparing the physical location of each shopper within the online shopping mall.

What Gusler does *not* do is measure distances between web pages. There is no such teaching or suggestion contained in the Gusler application. The Detailed Description section of Gusler uses the term "page" just three times, and in the specific context of discussing the mall directory front page 31 shown above in Figure 4. The Detailed Description section uses the term "web pages" *once*, with respect to a discussion on "hot spots" 62. Otherwise, the Gusler disclosure is wholly silent as to "web pages," let alone measuring a distance between two or more of them. This makes sense, as Gusler is directed to providing a geographical association between shoppers within a virtual floor plan of an online shopping mall: "The present invention provides an enhanced social experience coupled to an virtual shopping mall which creates an apparent geographical coupling between cyberstores within the virtual mall and shoppers within the mall." (Gusler at ¶ [0037])

To this end, the Examiner's reliance upon paragraph 62 of Gusler is misplaced. Paragraph 62 discloses the concept of a proximity detector that notifies shopper 38 when one or

more other shoppers currently within the online mall system are located at a position within the mall system that falls within a proximity zone 304 set up by shopper 38. For example, Figure 4 above shows shopper 302 within shopper 38's proximity zone 304. In paragraph 62, Gusler refers to the proximity zone 304 shown in Figure 4 as "a virtual distance radius" or "a parameter such as within the same virtual store."

The disclosures in paragraph 62, even in their broadest sense, cannot be read as teaching "calculating a virtual distance between a web page that a user is accessing through a first terminal and web pages accessed by other users." The "virtual distance radius or a parameter such as within the same virtual store" language in Gusler that the Examiner relies upon pertains to the physical locations of shoppers within the online shopping mall program. Gusler says nothing about web pages, nor is it otherwise proper to interject such language or infer such teaching. *See In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010) (finding that the PTO's practice of giving a claim the broadest, reasonable construction "does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent)."

Moreover, the Examiner's reference to language in paragraph 6 of Applicants' own specification actually *supports* this argument. Just like Applicants' recited claims, paragraph 6 relates to identifying web pages that are within a virtual distance of each other: "The software . . . . may determine and display to the user a list of other registered users who are presently visiting the same pages that are conceptually 'near' the web site or web page."

B. Herland Does Not Remedy Gusler's Deficiencies, Nor Is Combinable With Gusler To Create *Prima Facie* Obviousness Of Claims 1, 18, 19, 25, 28 And 32

The Examiner states that Gusler does not disclose "wherein the web page that the user is accessing and each of the web pages accessed by the other users comprise any web page on the Internet," but relies on Herland to remedy this deficiency: "Herland, in the same field of endeavor discloses communicating over the network (the internet or corporate intranet)." (Office Action, p. 3) Applicants respectfully traverse the Examiner's combination of these references.

A proper rejection under 35 U.S.C. § 103(a) should not use the pending claims as a "shopping list" for searching the prior art for descriptions of features that may be cobbled together in a manner allegedly similar to the claimed subject matter. Rather, a proper § 103(a) inquiry should address whether the prior art references, each taken in their entirety for all that they would reasonably teach to a skilled artisan at the time of the invention, would have rendered the claimed subject matter unpatentably obvious. Unfortunately, the rejections proffered by the Examiner in this case emphasize the first approach in assembling piecemeal elements from various references to create an alleged basis for *prima facie* obviousness and fail to consider whether the cited references, *when taken as a whole*, properly suggest the claimed subject matter in a manner that would have caused one of ordinary skill in the art at the time of the invention to have deemed it obvious.

First, even when combined, there remains a disclosure gap—neither reference teaches calculating a virtual distance between two <u>different</u> web pages. Herland requires that the web pages be the *same* and Gusler, as explained above, makes no reference to measuring distances between web pages. In other words, Herland does not remedy Gusler's deficiencies.

Second, combining the alleged "communicating over the network (the internet or corporate intranet)" disclosure of Herland with the alleged Gusler teachings would not have rendered Applicants' claimed methods and systems obvious to a skilled artisan at the time of Applicants' claimed invention. Although the Examiner jumps to this conclusion, it is not factually supported by the Gusler and Herland disclosures in view of applicable legal principles.

The technology disclosed in Gusler is limited to a closed system, *e.g.*, a software application, which identifies where users are within the closed system, akin to a video game. The technology disclosed in Herland is limited to identifying users positioned at the same web page. Neither reference teaches, nor suggests, a system for "calculating a virtual distance between a web page that a user is accessing . . . and web pages accessed by other users . . . wherein the web page that the user is accessing and each of the web pages accessed by the other users comprise <u>any web page on the Internet</u>." The Examiner appears to suggest that deriving and enabling such functionality would have been within the knowledge of a skilled artisan at the time of Applicants' invention, but points to nothing to support this assertion. The Examiner has

not identified any tea ching, suggestion or motivation in either cited reference, or provided support as to why a skilled artisan at the time would have had such technical ability to derive and enable Applicants' recited invention.

Applicants' respectfully submit that the methodologies for determining locations of individuals within a closed network (Gusler) and/or on the same web page (Herland) are wholly different from those associated with determining locations of individuals <u>anywhere</u> on the Internet. Without the cited references providing some apparent reason for doing so, combining the former methodologies to arrive at the latter (Applicants' invention) calls for more than the "inferences or creative steps" contemplated by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). In fact, only by improperly relying upon the disclosures contained in Applicants' claims and specification can the Examiner argue that it would have been obvious to combine Gusler and Herland to arrive at Applicants' recited invention.

C. Neither Gusler Nor Herland Enable Claims 1, 18, 19, 25, 28 And 32

A "conclusion of obviousness *requires* that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." MPEP § 2145 (emphasis added). Neither Gusler nor H erland teaches o r suggests how to arrive at the claimed systems and methods recited in Applicants' pending claims. And the Examiner has provided no additional reasoning or evidence as to why it would have been obvious to one of ordinary skill in the art to calculate a virtual distance between two different web sites anywhere on the Internet.

II.   35 U.S.C. § 103—Gusler–Herland In View of Other References

Claims 2, 5 and 12–17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gusler–Herland in view of various combinations with U.S. Patent No. 7,035,926 to Cohen *et al.*, U.S. Pat. Appl. Publ. No. 2005/0141688 to Wengrovitz, U.S. Pat. Appl. Publ. No. 2001/0027474 to Nachman *et al.* and U.S. Pat. Appl. Publ. No. 2001/0016825 to Pugliese III *et al.* Because claims 2, 5 and 12–17 each depend from amended independent claim 1, they incorporate the features recited in claim 1. Therefore, claims 2, 5 and 12–17 are patentable for at least the reasons noted above with respect to claim 1.

For at least the reasons stated above, Applicants' respectfully submit that independent claims 1, 18, 19, 25, 28 and 32, and claims 2–17, 20–24, 26, 27, 29–31 and 33–35 depending therefrom, are patentable over the cited references. Accordingly, Applicants respectfully request withdrawal of these rejections.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of the pending claim and allowance of this Application. In the event the Examiner has further questions or concerns after reviewing this submission, Applicants urge the Examiner to contact Applicants' representatives at the below listed phone number to help expedite the prosecution of this Application.

Applicants respectfully note that failure of Applicants to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. Nothing in this paper, nor any prior response or communication filed by Applicants, should be construed as an intent to concede any issue with regard to any claim, except as specifically stated. Applicants also reserve the right to pursue claims for the subject disclosure in either or both of the present and subsequent applications claiming benefit of the subject application. Such claims may include claims similar to the claims currently pending in the subject application, including broader aspects of such embodiments currently claimed, as well as other aspects and embodiments and inventions. To that end, any current amendments made to the claims or the presentation of new claims are relative only to particular embodiments among the numerous embodiments and inventions disclosed and/or taught by the present disclosure.

The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account **50-0311**, Reference No. **27683-011**. The Director is further authorized to charge any required fee(s) under 37 C.F.R. §§ 1.19, 1.20, and 1.21 to the abovementioned Deposit Account.

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Respectfully submitted,

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